

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 41

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIANGTAO WEN,
JOHN D. VILLASENOR and
JEONG-HOON PARK

Appeal No. 2005-0457
Application No. 09/203,672

HEARD; April 21, 2005

Before KRASS, BLANKENSHIP and NAPPI, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's decision regarding twice-rejected claims 8-11, and 14. Claims 12 and 13 have been indicated by the examiner as being directed to allowable subject matter and form no part of this appeal.

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The invention pertains to information transmission, specifically MPEG 4-type data. In particular, the invention improves upon the prior art technique of using a one-bit COD (extended code) field, indicating whether or not a motion vector (MV) and a discrete cosine transform (DCT) are encoded in a bit stream, by providing a field code having at least two bits. The two bit field code indicates whether both a MV and a DCT are not encoded, whether both the MV and DCT are encoded, and whether only the MV is encoded.

Independent claims 8 is reproduced as follows:

8. A method for use in a system in which information is transmitted, said method comprising the steps of:

generating an extended code (COD) field representing a coding state of said information; and

including, in said extended code field, a bit stream indicating whether both a motion vector (MV) and a discrete cosine transform (DCT) value are not encoded, whether both the MV and the DCT are encoded, or whether only the MV is encoded.

The examiner relies on the following reference:

Suzuki et al. (Suzuki)	6,097,842	Aug. 1, 2000
		(filed Sep. 5, 1997)

Claims 8-11, and 14 stand rejected under 35 U.S.C. §102 (e) as anticipated by Suzuki.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

Under 35 U.S.C. §102, a reference must disclose, explicitly or implicitly, every limitation of the claimed invention. Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.), cert. denied, 516 U.S. 988 (1995).

It is the examiner's view that Suzuki discloses the subject matter of independent claim 8 by generating an extended code (COD) field representing a coding state of the information (Figures 40A, COD); including, in the extended code field, a bit stream indicating whether both a MV and the DCT values are not encoded (column 33, lines 54-60), or whether only the MV is encoded (column 34, lines 1-40, and column 35, lines 1-3).

For their part, appellants argue, inter alia, that the examiner has mixed the functions of the COD and MODB in Suzuki as though these functions were included in a single flag (principal brief-page 5).

We have carefully reviewed the evidence of record, including the arguments of appellants and the examiner, and we conclude that the examiner has set forth a prima facie case of anticipation with regard to independent claim 8, in accordance with the examiner's broad, yet reasonable, interpretation of the claim language. Accordingly, we will sustain the rejection of claims 8-10, since appellants have grouped these claims together, under 35 U.S.C. §102 (e).

The examiner's explanation of the rejection clearly combines Suzuki's two Figures, Figure 40A and 40B. The examiner points to column 33, lines 54-63, for a disclosure of setting COD to 1 if there is no data to be transmitted, or setting COD to 0 for subsequent transmission of data. This refers to Figure 40A, showing the flag COD, arranged next to the leading first_MMR_code.

The examiner also points to column 34, lines 31-40, and column 35, lines 1-8, of Suzuki, for a showing of a bit stream indicating whether both a MV and the DCT values are not encoded, whether both are encoded, or whether only the MV is encoded. These sections of Suzuki refer to Figure 40B, and an MODB flag, arranged next to the leading first_MMR_code.

Thus, it would appear that the examiner relies on two different codes (COD and MODB) in Suzuki to provide for the functions of the instant claimed invention. However, independent claim 8 calls for "generating *an* extended code (COD) field" (emphasis added), meaning a *single* code (COD) field. The claim further specifies that this single code field must include a bit stream and that bit stream in the single code field must indicate "whether both a motion vector (MV) and a discrete cosine transform (DCT) value are not encoded, whether both the MV and the DCT are encoded, or whether only the MV is encoded." Therefore, if this was the examiner's only explanation of the rejection, it would fail.

However, the examiner also points out that because the three conditions recited in independent claim 8 are recited in the alternative, not all of the conditions must be taught by Suzuki in order to anticipate the instant claimed invention.

It is appellants' view, as was restated at the oral hearing by appellants' representative, that when the claim recites that the bit stream indicates "whether both a motion vector (MV) and a discrete cosine transform (DCT) value are not encoded, whether both the MV and the DCT are encoded, or whether only the MV is encoded," this means that the bit stream must be capable of all three conditions. If it is capable of all three conditions, appellants' argument goes, then it is clear that the extended code (COD)field must have more than a single bit, since a single bit can only depict one of two conditions. Appellants argue that despite the use of the disjunctive, "or," in the list of conditions, the bit stream of the COD field must be capable of representing the three cited conditions.

We have carefully reviewed the arguments of appellants and the examiner, as well as the claim language itself, and we find that the three recited conditions are, in fact, recited in the alternative, so that the meeting of at least one condition may anticipate claim 8. We reach this conclusion for a few reasons. First, if alternative language is not what was intended, it appears to us that it would have been a simple matter for the claim draftsman to write the claim to foreclose that possibility but,

instead, the three conditions are listed in the claim employing the disjunctive “or” rather than the conjunctive “and.” Moreover, claim 8 does not limit the extended code (COD) field to at least two bits, and this is made clear by an investigation of dependent claim 9, which does so limit the extended field code. Since claim 9, dependent on independent claim 8, and therefore further limiting claim 8, recites the extended field code as comprising “at least two bits,” it is clear that claim 8 is not so limited and, may, in fact, include extended field codes having one bit, as in the prior art. The fact that claim 8 is not so limited, leaving open the possibility of a one-bit extended field code, taken together with the alternative language, “or,” separating the recited three conditions, would appear to indicate that the code recited in claim 8 was not intended to be limited to the two-bits or more, necessary for representing three conditions.

Since we view independent claim 8 as requiring a single extended code (COD) field which includes a bit stream indicating whether any one of the three conditions is met, it is clear that this is met by Suzuki’s description, at column 33, lines 54-66, whereby a COD value of 1 indicates that both a motion vector and a discrete cosine transform are not encoded (i.e., there is no data to be transmitted).

Claims 9 and 10 fall with claim 8 because appellants group these claims together and do not argue them separately.

Claim 11 is argued separately (note pages 9-10 of the principal brief). Since this claim makes it clear that the single COD field has two bits, and further recites what condition is indicated by the bit values 11, 00 and 01, we will not sustain the rejection of claim 11 under 35 U.S.C. §102(e). For the reasons supra, Suzuki is not found to disclose a single extended field (COD) code having more than a single bit. It was improper for the examiner to rely on the two-bit MODB code, in combination with the one-bit COD code, in an attempt to anticipate a claimed requirement of a double bit COD field.

Finally, we consider the rejection of claim 14 under 35 U.S.C. §102 (e) over Suzuki.

We will not sustain the rejection of claim 14 under 35 U.S.C. §102 (e) because the examiner has merely asserted that "it is considered an inherently well known feature to encode only MV when motion of an image is constant in order to reduce bits required for coding video frames" (answer-page 4).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co. v.

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Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Id. at 1269, 20 USPQ2d at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

Where, as here, appellants have challenged the examiner's finding of inherency, the examiner was obligated to produce evidence that information in Suzuki is inherently encoded by using only MV, when motion of an image is constant. The examiner has not done so. Accordingly, we will not sustain the rejection of claim 14 under 35 U.S.C. §102 (e).

CONCLUSION




We have sustained the rejection of claims 8-10 under 35 U.S.C. §102 (e) but we have not sustained the rejection of claims 11 and 14 under 35 U.S.C. §102 (e).

Accordingly, the examiner's decision is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED-IN-PART

	
ERROL A. KRASS)
Administrative Patent Judge)
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HOWARD B. BLANKENSHIP)
Administrative Patent Judge)
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ROBERT E. NAPPI)
Administrative Patent Judge)

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